

REMARKS

In the Final Office Action, the Examiner rejected claims 2, 21, 23-26, 29 and 34-36 and objected to claim 22. By the present response, Applicants have amended claims 2, 23, 34 and 35 and canceled claim 22 without prejudice. Upon entry of the amendments, claims 2, 21, 23-26, 29 and 34-36 will be pending in the present application. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Objection

In the Final Office Action, the Examiner objected to claim 22. However, as discussed above, Applicants have canceled claim 22 without prejudice. As such, Applicants respectfully assert that a discussion regarding claim 22 is now moot.

Claim Rejections Under Section 112, First Paragraph

In the Final Office Action, the Examiner rejected claims 2, 21, 23-26 and 29 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Specifically, the Examiner stated that,

In Claim 2, the phrase of “winding wires on the bobbins of the plurality of segments” (line 10) is new matter. The specification and drawings, as originally filed, does [*sic*] not provide support for winding a single continuous length of wire on each segment and then, winding another set of “wires on the bobbins” of each segment. The specification (lines 3-8 of page 11) discloses a single winding operation with one single wire for each segment, or one single continuous wire for all of the segments, not multiple winding operations with each segment having more than one wire.

The same problem above also occurs in Claim 23 with the recitations of “winding wire on the bobbins of plurality of segments” (lines 12-13).

Final Office Action mailed June 2, 2004, p. 2. Applicants, however, respectfully assert that the instant claims, as pending, comply with Section 112, first paragraph.

By the present response, Applicants have amended claims 2 and 23. Specifically, the recitations presented by the Examiner have been amended to recite “winding the single continuous length of wire on the bobbins of the plurality of segments about the central axis.” With these amendments in mind, Applicants respectfully request that the Examiner withdraw the Section 112, first paragraph rejections and allow the instant claims.

Claim Rejection Under Section 112, Second Paragraph

In the Final Office Action, the Examiner rejected claims 2, 21, 23-26 and 29 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Specifically, the Examiner stated,

In Claim 2, it unclear [*sic*] from the disclosure what is meant by the phrase of “winding wires on the bobbins of plurality of segments” (line 10). Furthermore, the limitations of “maintaining the wire of each segment on the bobbin on which the wire was wound” (lines 15-16) are confusing, misleading and renders the claims as being vague and indefinite. It is unclear which previous recitation the limitation of “maintaining the wire” is referring to, such as the “single continuous length of wire” (lines 4-5) or “winding wires” (line 10).

In Claim 23, the same problems in Claim 2 above also occur in Claim 23 with the limitations of “winding wire on the bobbins” (lines 12-13) and “maintaining...was wound” (lines 28-29).

Final Office Action mailed June 2, 2004, pp. 3-4. Applicants respectfully assert that the instant claims, as pending, comply with Section 112, second paragraph.

By the present response, Applicants have amended claims 2 and 23. Specifically, the recitations presented by the Examiner have been amended to recite “the single continuous length of wire.” With these amendments in mind, Applicants respectfully request that the Examiner withdraw the Section 112, second paragraph rejections and allow the instant claims.

Rejection Under 35 U.S.C. § 102

In the Final Office Action, the Examiner rejected claims 34 and 35 under 35 U.S.C. § 102(e) as being anticipated by the Takehara reference (U.S. Patent No. 6,163,952). Applicants respectfully traverse the rejection, because the cited reference fails to disclose all of the features recited in the instant claims.

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

In one exemplary embodiment, the present invention provides a method for winding a segmented stator of rotor of an electromechanical device. See Application, p. 1, ll. 1-3. To wind the segments 15a-15d, they are placed in a side-by-side orientation with respect to one another along an axis of rotation and are interspaced by nests 22a-22e. See *id.* at FIG. 1; p. 9, ll. 8-16. Once properly arranged, the exemplary method calls

for the winding of a single continuous length of wire onto the segments and about the axis of rotation introduced above. *See id.* at p. 9, ll. 10-12; FIG. 1 (noting that in FIG. 1 the axis of rotation is in the illustrated X-axis direction). Specifically, in the exemplary embodiment, a bobbin winder assembly 30 travels in a direction parallel to the axis of rotation and, concurrently, feeds wire on the rotating segments 15a-d, which are rotating with respect to the above-introduced axis of rotation. *See id.* at p. 9, l. 18 to p. 10, l. 15. (In an alternate and exemplary embodiment, the segments 15a-d remain stationary as the bobbin winder assembly rotates with respect to the axis of rotation.) With the foregoing exemplary embodiment in mind, Applicants respectfully assert that the cited reference fails to disclose all of the features recited in the instant claims.

Independent claim 34 recites as follows:

A method of winding segment of a segmented wound member of an electromechanical device, comprising:

(A) Arranging a plurality of stator segments in a side-by-side orientation along an axis of rotation, each stator segment of the plurality of stator segments comprising a respective, separate bobbin; and

(B) winding a wire dispensed from a wire dispenser permanently onto the bobbin of each of the plurality of segments about the axis of rotation such that the plurality of segments are electrically in series.”

(Emphasis added.) Respectfully, Applicants assert that the Takehara reference does not disclose all of these features.

The Takehara reference discloses a method for manufacturing a motor armature. *See Takehara*, col. 3, ll. 1-5. The Takehara motor armature comprises a plurality of plurality of pole pieces 3 that each includes a coil 4 wound around a wire piece 5. *See id.* at col. 3, ll. 25-30. To form the pole pieces, FIG. 8 the Takehara reference illustrates that individual pole pieces 3 are arranged next to one another for a winding process, the pole

pieces being arranged such that the longitudinal axis of each pole piece comes out of the page. *See id.* at FIG. 8; col. 5, ll. 59-63. Once arranged, the Takehara reference illustrates a winding device 21 that winds a coil 4 onto the wire piece by dispensing a coil 4 as the winding device 21 rotates about the longitudinal axis of the pole piece 3. *See id.* at FIG. 10; col. 6, ll. 4-11. Thus, the axis about which each pole piece 3 of Takehara is wound is transverse to the axis along which the pole pieces 3 are arranged. Accordingly, the Takehara reference, in contrast to the subject matter of the instant claim, discloses a method of winding coil 4 onto pole pieces about an axis of rotation and arranging the pole piece along a second axis that is perpendicular to the axis of rotation. Therefore, the Takehara reference fails to disclose the acts of winding about the axis of rotation and arranging along the axis of rotation as recited in the instant claim. Indeed, the Examiner in a previous Office Action appears to have agreed with this position by stating that “Applicants [*sic*] arguments drawn to the limitations of ‘along an axis of rotation’ have been found to be persuasive [*sic*] with respect to the merits of Takahara [*sic*].” Advisory Action mailed August 30, 2001, p. 2.

Therefore, Applicants respectfully assert that the Takehara reference fails to disclose all of the features recited in the instant claim and, as such, fails to anticipate independent claim 34 and its respective dependent claim 35. With the foregoing in mind, Applicants respectfully request reconsideration and allowance of the instant claims.

Rejection Under Section 103

In the Final Office Action, the Examiner rejected dependent claim 36 under 35 U.S.C. § 103(a) as obvious in view of the Takehara reference and the untranslated Murata reference (Japan Patent No. 60-182119; hereinafter the ‘119 reference). Applicants respectfully traverse the rejection, because the cited references, taken alone or in combination, fail to disclose all of the features recited in the instant claims and because the cited references fail to present the requisite motivation for combination.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

As discussed above, the Takehara reference fails to disclose all of the features recited in the independent claim (i.e., claim 34) from which dependent claim 36 depends. Moreover, neither the Examiner nor the '119 reference itself suggests that the '119 reference is capable of obviating the deficiencies of the Takehara reference as discussed above.

Furthermore, based on the limited disclosure of the '119 reference, it appears that the '119 reference teaches away from combination with the Takehara reference to reach the instant claim. A *prima facie* case of obviousness cannot stand if the prior art, "in any material respect," teaches away from the claimed invention. *See In re Geisler*, 43 U.S.P.Q.2d 1362, 1366 (Fed. Cir. 1997) (emphasis added); *see also* M.P.E.P. § 2144.05, ¶ III. The Takehara reference appears to disclose a stepped bobbin 2 in which each step is wound with a strip 1 from a dedicated supply 3. *See* '119 reference, CONSTITUTION. As illustrated, the bobbin 2 of Takehara has 4 concentric step portions, each fed by its own supply reel 3. *See id.* Accordingly, the '119 reference teaches the use of multiple and disjointed strips and, as such, is antithetical to the single, continuous wire recited in the instant claim.

Therefore, Applicants respectfully assert that the cited references, taken alone or in combination, do not render the instant claim obvious. With the foregoing in mind, Applicants respectfully request that the Examiner withdraw the present rejections and allow the instant claims.

Additionally, Applicants respectfully request that the Examiner provide a translation of the '119 reference if it is to be relied upon as support for a rejection of the instant claim. Respectfully, Applicants assert that it is improper for the Examiner to rely on the abstract rather than the underlying document itself, particularly in the case of foreign language references. *See Ex parte Jones*, 62 U.S.P.Q.2d 1206 (PTO Bd. App. 2001) (unpublished). As noted by the Board of Patent Appeals and Interferences, reliance on abstracts is problematic, because abstracts are often prone to erroneous or incomplete descriptions of the invention. *See id.* Moreover, the text of a reference, upon which the abstract is based, may present evidence that contradicts the abstract and that teaches away from the Examiner's proposed modification or combination. *See id.* Indeed, the underlying text of the '119 reference may contain any number of facts and/or statements that contradict or clarify the summarized statements in the brief and translated abstract. The '119 reference simply must be considered as a whole, and such consideration is not possible absent a complete translation.

Along this vein, the M.P.E.P. states that "[c]itation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art." M.P.E.P. § 706.02, p. 700-20 (citing *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished)). The M.P.E.P. further states that "[t]o determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed." *Id.* (emphasis added). If the relied-upon document is in a language other than English, the M.P.E.P. mandates that "a translation must be obtained so that the record is clear as

to the precise facts the examiner is relying upon in support of the rejection” and that “[t]he record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection.” *Id.* (emphasis added). Moreover, the Board of Patent Appeals and Interferences has stated that “[i]f a translation is not provided by the examiner, the applicant may wish to consider seeking supervisory relief by the way of a petition (37 C.F.R. § 1.181) to have the examiner directed to obtain and supply a translation.” *Id.* at 1208-09 (emphasis added).

Accordingly, if the Examiner wishes to employ the ‘119 reference as prior art against the instant application, Applicants respectfully request that the Examiner provide an English translation of the ‘119 reference and cite specific passages of the translated reference as mandated by the M.P.E.P.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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